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Date: 6-27-05Himanshu S. Amin

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Applicant(s): Jeff A. Zimmewicz, *et al.*

Examiner: Michael J. Yigdall

Serial No: 09/771,761

Art Unit: 2192

Filing Date: January 29, 2001

Title: SYSTEM AND METHOD TO FACILITATE INSTALLATION AND/OR
REMOVAL OF COMPONENTS

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REPLY BRIEF

Dear Sir:

Appellants' representative submits this Reply Brief in response to the Examiner's Answer mailed April 25, 2005. A Request for Oral Hearing is being submitted concurrently herewith. Further, a credit card payment form is filed concurrently herewith in connection with all fees due regarding this document and the Request for Oral Hearing. In the event any additional fees may be due and/or are not covered by the credit card, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1063 [MSFTP195US].

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A. Grouping of Claims

The Examiner asserts at page 2 of the Examiner's Answer that appellants' Appeal Brief does not include a statement that pertains to the grouping of claims that stand and fall together as required by 37 C.F.R. §1.192(c)(7). Appellants' representative notes however that, as of September 13, 2004, the provisions of 37 C.F.R. §41.37 have superseded the requirements of 37 C.F.R. §1.192. Under the new provisions as promulgated by 37 C.F.R. §41.37 there is no requirement for appellants' Appeal Brief to include a statement regarding the grouping of claims and reasons in support thereof. Consequently, in conformance with, and as required by, the new rules governing Appeal Briefs, the grouping of claims section has been omitted.

B. Regarding Independent Claim 25

The Examiner contends at page 4 of the Examiner's Answer that: "this is the first time Appellant has raised the issue of 35 U.S.C. §112, sixth paragraph." In response, appellants' representative directs the Examiner's attention to the provisions of 37 C.F.R. §41.37(c)(1)(v) that states:

... every means plus function and step plus function as permitted by 35 U.S.C. §112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to drawing, if any, by reference characters.

Thus, while appellants' representative acknowledges that this is the first time that the issue of 35 U.S.C. §112, sixth paragraph has been raised, the raising of the issue has been precipitated by the aforementioned requirements that require that every means plus function be identified and the structure corresponding to each claimed function pertaining thereto must be set forth with reference to the specification by page and line number.

With reference to the Examiner's assertion that appellant has failed to provide "an analysis of how the language of the claim should be interpreted", (See Examiner's Answer, page 4), appellants' representative entreats the Examiner to peruse MPEP

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§2181(I) which sets forth the requirements for interpretation of claim limitations that fall within the purview of 35 U.S.C. §112, sixth paragraph, *i.e.*, (A) the claim limitations must use the phrase “means for” or “step for”; (B) the “means for” or “step for” must be modified by functional language; and (C) the phrase “means for” or “step for” must not be modified by sufficient structure, material or acts for achieving the specified function. (See MPEP §2181(I)). It is submitted that the limitations set forth in independent claim 25 satisfy these requirements; each claim limitation utilizes the phrase “means for”; as the Examiner clearly concedes, each claim limitation is modified by functional language; and the “means for” phrase is not modified by structure for achieving the specified function. Thus, it is believed that the limitations enumerated within independent claim 25 clearly fall within the ambit of 35 U.S.C. §112, sixth paragraph.

In reference to the Examiner’s assertion that “the examiner could not discern any particular means and/or explanation made as to how each of these acts should be performed”, (See Examiner’s Answer, page 4), the Examiner is directed to MPEP §2181(II) that provides the proper test for ascertaining the support necessary to found a claim limitation that invokes 35 U.S.C. §112, sixth paragraph. According to the indicated section of the MPEP, means plus function language should be construed to cover corresponding structure described in the specification and equivalents thereof, in a way that one skilled in the art will understand what structure will perform the recited function. Moreover, according to the noted section, the written description does not have to explicitly describe the structure corresponding to a means-plus-function limitation; the disclosure of the structure may be implicit or inherent in the specification if it would have been clear to those skilled in the art what structure corresponds to the means plus function claim limitation. *See e.g., Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 53 USPQ2d 1225 (Fed. Cir. 1999). Appellants’ representative therefore asserts that the paragraphs indicated in the Appeal Brief, *viz.*, exemplary paragraphs [0009]-[0010], provide one of ordinary skill in the art the necessary structure to both comprehend and perform the recited function. Other locations within the specification where the Examiner can find the support for the structure necessary for one ordinarily skilled in the art to be able to comprehend and perform the functions recited in the instant means plus

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function claim can be found, for example, at paragraphs [0025]-[0033], paragraphs [0034]-[0045], *etc.*

C. Regarding the Rejection of Claims 1, 8-13, 16, 18, 21-22 and 25-26 Under 35 U.S.C. §102(e)

Claims 1, 8-13, 16, 18, 21-22 and 25-26 stand rejected under 35 U.S.C. §102(e) as being anticipated by Curtis (US 6, 442,754). Reversal of this rejection is respectfully requested for at least the following reasons. Curtis does not disclose or suggest all limitations set forth in the subject claims.

Appellants' claimed invention relates to a system and method to help manage installation and/or removal of components, in which at least one of the components is a shared component. In particular, independent claims 1, 13, 25 and 26 recite: *a validation engine operative to provide a valid order*, and *an installer operative to control at least one of an installation and removal operation of components based on the valid order*. Curtis does not disclose or suggest these novel aspects of the invention as claimed.

Curtis provides a system, method, program and data structure for installing a program on a computer. Specifically, the cited document discloses a check_dependency function that determines whether a file, program or registry object indicated in a dependency list is installed on the computer. The Examiner asserts that Curtis provides a validation engine to provide a valid order for the installation of components because all components that are identified by the check_dependency function as being dependent must be installed prior to the installation of the depending program. While appellants' representative does not disagree with the characterization that the cited document requires that dependent components be installed before installation of depending components, appellants' representative nevertheless still maintains that Curtis does not provide a valid order prior to the installation of components. Appellants' representative's contention can be best illustrated through example. Suppose that component one has two dependent components, component two and component three, wherein components two and three are not dependent on one another. Also assume that *either* component two or component three can be installed in combination with component one, or alternatively, both

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components two and three can be installed with component one. Further assume that when components one, two and three are installed in combination, component two must be installed prior to component three. Under Curtis' conception the check_dependency function will detect that components two and three depend from component one, but will not realize that component two must be installed prior to component three when components one, two and three are to be installed in combination. In contrast, the invention as claimed will detect and be cognizant that component two must be installed prior to component three when all three components are installed together, therefore appellants' claimed invention will provide a valid ordering with respect to the three exemplary objects.

The Examiner further contends that Curtis discloses an install program that installs components based on a valid order. As stated *supra*, the check_dependency function provided by the cited document does not provide a valid order, but instead accounts for dependency between components where such dependency exists. Thus, it is submitted that since Curtis fails to provide a valid ordering of the components to be installed, the cited document cannot possibly be basing the installation of components on an ascertained valid order. Rather, it is averred that Curtis bases the installation of components on the respective dependency of components with one another.

The Examiner also notes that the terms "impose" and "establish" are not recited in the subject claims, and that the term "providing" is utilized therein. Appellants' representative acknowledges that these terms are not recited in the claims, but it is submitted that during argument, in an attempt to impress upon the Examiner the distinction between appellants' claimed invention and the cited art, various synonyms can be, and were, utilized to convey the distinctions upon which the cited document and the invention as claimed can be distinguished.

In addition, the Examiner is reminded that the standard by which anticipation is to be measured is *strict identity* between the cited document and the invention as claimed, not mere equivalence or similarity. See, *Richardson* at 9 USPQ2d 1913, 1920. This means that in order to establish anticipation under 35 U.S.C. §102, the single document cited must not only expressly or inherently describe each and every limitation set forth in

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the patent claim, but also the identical invention must be shown in as complete detail as is contained in the claim. Thus, it is submitted, since Curtis fails to disclose a validation engine that provides a valid ordering, and further because the cited document does not base installation of components on the valid ordering provided by the validation engine, that Curtis and the invention as claimed are clearly distinguishable.

In view of at least the foregoing, reversal of the rejection of independent claims 1, 13, 25 and 26 (and claims that depend there from) is respectfully requested.

D. Regarding Rejection of Claims 2-4, 14-15, 17, 23-24 and 29-31 Under 35 U.S.C. §103(a)

Claims 2-4, 14-15, 17, 23-24 and 29-31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Curtis as respectively applied to claims 1, 13 and 26 and in view of Taylor. This rejection should be withdrawn for at least the following reasons. Curtis and Taylor, either individually and/or in combination, fails to teach or suggest each and every limitations set forth in the subject claims.

Independent claims 23, 24 and 31 recite similar limitations, namely: *a validation component operative to provide a valid order*, and *a setup engine operative to initiate installation of each of the components according to the valid order*. Curtis and Taylor, either alone or in combination, do not teach or suggest these novel aspects of appellants' claimed invention.

As has been discussed in the Appeal Brief, and is reiterated herein, Curtis does not disclose providing a valid ordering that is subsequently utilized to initiate installation of components according to the validated order. Rather, Curtis provides a `check_dependency` function that determines whether files or programs are currently installed on a computer. Additionally, Taylor does not cure these deficiencies in Curtis, and for this reason alone the rejection should be withdrawn.

While appellants' representative is cognizant, as the Examiner asserts, that Taylor was not relied upon to introduce the alleged aforementioned features to Curtis, it is nevertheless appellants' representative's position that Curtis does not teach or suggest the elements for which the Examiner cites the document, and that Taylor does not rectify

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those deficiencies. Consequently, it is posited, even if Taylor were to provide in totality those portions of the teaching upon which the Examiner relies to substantiate the rejection, the combination of Curtis and Taylor would still not teach or suggest the entirety of appellants' claimed invention.

Accordingly, in view of at least the foregoing, withdrawal of the rejection of independent claims 23, 24 and 31, and associated dependent claims, is requested.

E. Regarding Rejection of Claims 5-7, 19-20 and 27-28 Under 35 U.S.C. §103(a)

Claims 5-7, 19-20 and 27-28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Curtis as applied to claims 1, 18 and 26 above and in view of Kruger *et al.* (US 6,367,075). Reversal of this rejection and allowance of the subject claims is respectfully requested for at least the following reasons. Claims 5-7, 19-20 and 27-28 depend from independent claims 1, 13 and 26 respectively, and Kruger *et al.* does not makeup for the aforementioned deficiencies with respect to Curtis. Accordingly, this rejection should be withdrawn.

09/771,761MS160268.01/MSFTP195US**CONCLUSION**

For at least the above reasons, the claims currently under consideration are believed to be patentable over the cited references. Accordingly, it is respectfully requested that the rejections of claims 1-31 be reversed.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063[MSFTP195US].

Respectfully submitted,
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